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10/821,004

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

MAIL DATE

DELIVERY MODE

08/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,004

Applicant(s)

ADAMS ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I, directed towards Claims 1-9, 11-21 and 23-27, in the reply filed on 2/2/07 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "second bulk coin storage receptacles" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claims 8 and 9 recite the limitation "skimmer mechanisms" in lines 4 and 2 respectively. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "denomination sensors" is unclear because the specification refers to various sensors in relation to "denominations". For example, Applicant's specification at paragraph 40 refers to sensors (88) which "sense and count denominations sorted by sorter (21)." Also, in paragraph 48, count sensors (90) are described as enabling "the main processor board (84) to track the amount of each denomination that is dispensed."

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Additionally, coin handling devices such as Applicants' tend to have sorting discriminators which include sensors that detect the specific denomination of a coin.

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 18 recites the limitation "user" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-9, 12-21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,318,537 B1) in view of Harris (US 5,067,928).

Regarding Claims 1, 18 and 26, Jones discloses a coin recycling machine (10) having a housing, as illustrated in figures 1 and 2, an intake area (14), a sorting mechanism (32, 250), as illustrated in figures 2, 20 and 21 and discussed at col. 18, lines 50-67, a plurality of dispensing hoppers (402a-f), as illustrated at figures 20, 21 and discussed at col. 18, line 50-col. 19, line 25, coin transfer mechanisms (256, 258a-d) and 260-265), as discussed at col. 20, lines 3-18 and col. 14, lines 25-67, a controller (39), that calculates first totals from the intake area through coin processor (32) and second totals for coins being dispensed via coin counters (404a-f). See also col. 19, lines 20 and 21, which states that the values for coins transported to an operator are calculated.

Regarding Claims 1 and 26, Jones does not expressly disclose, but Harris discloses using a bulk coin receptacle, (70), to fill a dispensing hopper (56) when a low condition is sensed in the primary hopper, for the purpose of increasing the capacity of the machine, thereby reducing the need to replenish the machine and the cost of labor as well as reducing machine downtime. See Harris at col. 1, line 61-col. 2, line 35, which describes the problem of dispensing hopper depletion which causes machine downtime. Note also that Harris discloses at col. 3, lines 10-33 that a set of sensors detect the levels of both the bulk coin receptacle and the dispensing hopper.

Such frequent refilling requires extra labor than a machine which reduces refilling. Note also that Jones mentions at col. 18, lines 23-49 an intent to reduce such downtime.

Further regarding Claims 2, 8, 9, 16, 21, Harris discloses a transfer mechanism comprising a platform (90), which lifts coins from the bottom of the bulk coin receptacle (70) towards the top opening (78a, b), where coins at the top of the column of coins are "skimmed" off the top by "skimmer" (116) which transports the coins to the dispensing hopper from the bulk coin storage receptacle by pushing them through opening (78a, b), as illustrated in figures 5-6 of Harris and discussed at col. 3, lines 10-33 and col. 9, line 56-col. 10, line 3.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a bulk coin receptacle and associated transfer mechanism to each of Jones' dispensing hoppers (402a-f), as taught by Harris, for the purpose of increasing coin storage capacity, thereby reducing machine downtime and labor associated with servicing the coin machine.

Further regarding Claims 1, 18 and 26, although Jones does not expressly disclose comparing the first and second totals, it would have been obvious to one of ordinary skill to perform this step as Jones' system discloses collecting such data and therefore making it "available" to a user, as called for in the last two lines of Claim 1, for the purpose of accounting for coins processed by Jones' apparatus. Therefore, it would have been obvious for one ordinarily skilled in the art to have performed the method steps of Claims 18 and 26 using Jones' apparatus.

Regarding Claim 3, Jones also discloses that the controller (39) has a plurality of control circuits that controls transfer of coins from each coin receptacle station (40). See col. 7, lines 8-22 and 34-48.

Note that it would have further been obvious to cause each control circuit for each receptacle station to control the transfer of coins between the dispensing hopper and the bulk storage receptacles.

Regarding Claims 4 and 5, note that it would have been obvious to make the bulk coin storage receptacles of any particular capacity size ratio with respect to the dispensing hoppers based upon the requirements of the operator's business. See col. 15, lines 33-41 of Jones.

Regarding Claims 6, 19 and 27, Jones states that both coin input valuation and coin output valuation can be performed at the same time. See Jones at col. 19, lines 7-25.

Regarding Claims 7 and 20, Jones discloses at figure 3, for example, coin diverters (44, 46a and 46b) located near exits leading to either coin bags (52) or coin receptacles (54, 56). It therefore would have been obvious to divert coins from the bulk coin receptacles to either the dispensing hoppers or to the coin bags directly, according to the volume requirements of the operator's business. See again, Jones at col. 19, lines 7-25. One ordinarily skilled would have found it obvious to divert coins from the bulk coin receptacles rather than the dispensing hoppers so as to not disturb the dispensing hoppers, which service users. Therefore, the bulk coin receptacles would act as a buffer

Regarding Claims 12, 13, 23 and 24, Jones discloses a media reader device (24) that can read an identification card or a smart card and has various memory storage, as discussed at col. 5, lines 25-37. Col. 1, lines 20-27, col. 2, lines 10-24 and col. 5, lines

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23 and 24 disclose that Jones' machine can credit a user's account. As Jones also discloses at col. 19, lines 20-21, that value totals are maintained, it is considered to be obvious to one of ordinary skill in the art to have connected the system controller (39) to a memory that stores the various user accounts, input and output values for plural users, as this is a standard method for storing and manipulating the data discussed by Jones.

Regarding Claims 14 and 25, Jones discloses a touch screen at (12) at col. 4, lines 45-51 and col. 5, lines 28-33.

Regarding Claim 15, although Jones does not expressly disclose use of a personal computer or microprocessor, it is considered to be obvious to one of ordinary skill in the art to install such a controller in the form of either a computer or a microprocessor in order to process the data and controls described by Jones, since only a solid-state computer, microprocessor or the equivalent would efficiently process such data and control instructions as described by Jones. Note also that such a solid-state microprocessor or computer is a small, compact control device that preserves space for other components.

Regarding Claims 17, note that the term "denomination sensor" is interpreted as being a sensor that counts coins. Jones' discloses counting sensors (404a-f), as described at col. 19, lines 10-21. See also Jones at col. 19, lines 40-55. Regarding personal accounts, again note Jones at col. 1, lines 20-27, col. 2, lines 10-24 and col. 5, lines 23 and 24 which discloses that Jones' machine can credit a user's account. Again, note that col. 19, lines 20-21 describes maintaining value totals.

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11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,318,537 B1) in view of Harris (US 5,067,928) and further in view of Petri (US 5,830,054).

Jones discloses the system described above. Note again that Jones at col. 6, line 61-col. 7, line 7 discloses using various coin receptacles. Figure 3 of Jones illustrates coin bags and coin boxes being used.

Jones does not expressly disclose, but Petri discloses cash drawer at figure 3 and col. 5, lines 8-17.

At the time of the invention, one ordinarily skilled in the art would have found it obvious to fill a cash drawer as a coin receptacle, as taught by Petri, with Jones' coin dispensing device in light of Petri's teaching of filling cash drawers and Jones' teaching of filling various coin receptacles with his coin dispensing system.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-9, 11-21 and 23-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-18 of U.S. Patent No. 6,983,836 in view of Harris U.S. Patent No. 5,067,928.

Adams discloses a cash input area, a sorting mechanism, plural receptacles, plural denomination sensors, and a controller. See Adams, Claim 1, for example.

Adams does not expressly disclose, but Harris discloses using a bulk coin receptacle, (70), to fill a dispensing hopper (56) when a low condition is sensed in the primary hopper, for the purpose of increasing the capacity of the machine, thereby reducing the need to replenish the machine and the cost of labor as well as reducing machine downtime. See Harris at col. 1, line 61-col. 2, line 35, which describes the problem of dispensing hopper depletion which causes machine downtime. Note also that Harris discloses at col. 3, lines 10-33 that a set of sensors detect the levels of both the bulk coin receptacle and the dispensing hopper.

Such frequent refilling requires extra labor than a machine which reduces refilling.

Further regarding Claims 2, 8, 9, 16 and 21, Harris discloses a transfer mechanism comprising a platform (90), which lifts coins from the bottom of the bulk coin receptacle (70) towards the top opening (78a, b), where coins at the top of the column of coins are "skimmed" off the top by "skimmer" (116) which transports the coins to the dispensing hopper from the bulk coin storage receptacle by pushing them through

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opening (78a, b), as illustrated in figures 5-6 of Harris and discussed at col. 3, lines 10-33 and col. 9, line 56-col. 10, line 3.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a bulk coin receptacle and associated transfer mechanism to each of Adams' dispensing hoppers (402a-f), as taught by Harris, for the purpose of increasing coin storage capacity, thereby reducing machine downtime and labor associated with servicing the coin machine.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey A. Shapiro
Examiner
Art Unit 3653

August 20, 2007